

REMARKS

The Final Action made new rejections based on art recently discovered and cited by applicant.

These rejections are also predicated on various assertions of Official Notice.

So that applicants and the Board can correctly assess whether the art fairly suggests the claimed combinations, and determine whether *prima facie* obviousness has been established, the Examiner is requested to cite printed publications illustrating the various features for which Official Notice is taken.

Such a request is not believed to be burdensome; such notice can only be taken of facts that are "capable of instant and unquestionable demonstration as being well-known." (MPEP § 2144.03.)

The Examiner is also invited to consider whether a replacement Final Action should be issued that is not based on Official notice. As the MPEP counsels in § 2144.03:

*Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection.<sup>1</sup>*

Applicants also note that the MPEP sanctions use of Official Notice only in circumstances where it serves to "fill in the gaps in an insubstantial manner." In the present case, in contrast, Official Notice has been taken of important claim limitations that go to the heart of patentability. (To give but one example, the concluding clause of claim 3 defines an important claim limitation that is dismissed by reference to Official Notice. That limitation reads, "*thereafter querying the user regarding possible purchase of an item not selected by the user but on said recalled list, before completing the online shopping session.*")

It will be recognized that proving a negative, such as providing the *absence* of common knowledge, is a daunting – if not insurmountable – burden. In the present case, applicants respectfully traverse the finding of Official Notice on which rejection of claim 3 is based. The Action states, "Providing information about an apparent missed product

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Emphasis added.

such as something used in a recipe is old and well known in the art.” Unlike the examples given in the MPEP (e.g., “it is old to adjust intensity of a flame in accordance with the heat requirement;” and “tape recorders commonly erase tape automatically when new ‘audio information’ is recorded on a tape which already has a recording on it”), the asserted statement applied against claim 3 does not seem to meet the test of a fact capable of instant and unquestionable demonstration.

Similarly, in claims 5, 6, 13 and 14, the Action states “*Providing information about an apparent missed product such as under the conditions stated in claims 5, 6, 13 and 14 is old and well known in the art.*” Again, applicants do not believe the cited assertion, under the conditions stated in claims 5, 6, 13 and 14, is a fact capable of instant and unquestionable demonstration, as required for Official Notice. This use of Official Notice is thus respectfully traversed.

In claim 18, the Action relies on Official notice for the concluding limitation, “*identifying items of potential interest by reference to the shopper’s prior shopping history, where said history includes transactions with vendors other than said first vendor.*” Use of Official Notice here is respectfully traversed. For one, it goes to the heart of the claim, and is not applied to “fill in the gaps in an insubstantial manner.”

Moreover, the italicized claim language is not believed to be a fact capable of instant and unquestionable demonstration.

In contrast to the foregoing traverses of application of Official Notice, applicants do not substantively dispute that RFIDs are well known, and serve to identify items to which they are attached (rejection of claim 11).

In the rejections of claims 26 and 27, it appears Official Notice is not relied upon. (Neither the term Official Notice, nor a phrase such as “old and well known in the art” is used in the explanation of these rejections.) If this understanding is erroneous, the Examiner is requested to so-state.

The Examiner is requested to reconsider his reliance on Official Notice, and possibly issue a replacement Final Action that better comports with the MPEP. (In any event, citation of particular printed publications supporting the Official Notice is requested.)

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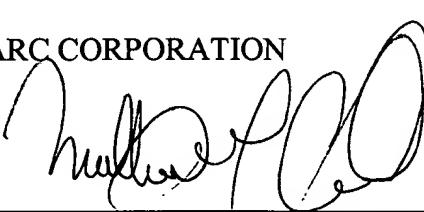
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Respectfully submitted,

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